

Application No.: 10/727,292

Docket No.: JCLA12308

REMARKS**Present Status of the Application**

The Office Action mailed February 7, 2005 rejected all presently pending claims 1-6. Specifically, claims 1-4 were rejected under 35 U.S.C. 102(b) as being anticipated by Bryan et al. (US 5,994,508, hereinafter Bryan), and claims 1-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan in view of Obata et al. (US 6,444,239 B2, hereinafter Obata). In response thereto, Applicants have amended independent claim 1 and addressed the following arguments. Reconsideration of claims 1-6 is respectfully requested.

Discussion of Rejections under 35 U.S.C. 102(b)

Claims 1-4 were rejected under 35 U.S.C. 102(b) as being anticipated by Bryan. Please note that Applicants have amended claim 1 to clarify its scope.

To establish the prima facie of rejection under 35 U.S.C. 102(b), it is required that every feature of the invention is disclosed in a single document. Applicants respectfully submit that Bryan does not disclose every feature of this invention, and therefore request reconsideration and withdrawal of the corresponding rejections.

Specifically, one feature of independent claim 1 is the step of *removing the insoluble materials* from the soybean extract liquid and collecting the remaining soybean extract liquid to obtain a composition containing soluble isoflavones.

Bryan fails to disclose the above feature, and even *teaches away to adopt the feature step*. According to claim 1 and col. 3, lines 8-14 of Bryan, a protein material containing isoflavones is

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precipitated and separated from the soybean extract liquid to produce an isoflavone-rich protein material. Obviously, it is the insoluble material that is *collected* in Bryan. On the contrary, in claim 1 of this invention, the insoluble materials are *removed* from the soybean extract, while *the remaining soybean extract liquid that contains soluble materials is collected instead*.

Accordingly, not only the method of this invention is quite different from that of Bryan, but also the composition containing soluble isoflavones obtained from the method of claim 1 is quite different from the isoflavones-rich protein material obtained from Bryan, since the former is in a liquid state and the latter is in a solid state mainly composed of proteins.

For at least the above reasons, Applicants respectfully submits that independent claim 1 and claims 2-4 dependent from claim 1 patently define over the prior art under 35 U.S.C. 102(b).

Discussion of Rejections under 35 U.S.C. 103(a)

Claims 1-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan in view of Obata.

As mentioned above, Bryan fails to disclose the above feature of independent claim 1 and even teaches away to adopt the feature step. Obata also fails to disclose the same feature and even *teaches away to adopt the feature step*. According to the Abstract and col. 1, lines 55-62 of Obata, the water-soluble components are separated from the enzymatic reaction mixture and the water-insoluble matter is recovered (=collected) as in Bryan.

For at least the above reasons and the same reasons provided in the above discussion of rejections under 35 U.S.C. 102(b), Applicants respectfully submit that independent claim 1 and claims 2-4 dependent from claim 1 patently define over the prior art under 35 U.S.C. 103(a).

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As for claims 5-6, the purpose of the protease treatment in Obata is quite different from that in this invention. According to col. 3, lines 52-54 of Obata, the protease treatment in Obata can enrich the *insoluble* matter of Bryan or Obata with isoflavones, because β -glucosidase is *used to hydrolyze the isoflavone glycosides* to form isoflavones that are less soluble in water (col. 3, lines 6-54).

On the contrary, according to [0018] and [0019] of the specification of this invention, the protease treatment is used mainly for hydrolyzing the proteins to improve the co-precipitation problem of proteins and isoflavones for enriching the *soluble* matter with isoflavones, while the source of the proteases used has a *low* β -glucosidase activity for *preventing hydrolysis of the isoflavone glycosides* into less soluble isoflavones.

Accordingly, the effect of the protease treatment in this invention is *contrary* to that in Obata due to the significant difference in β -glucosidase activity. Therefore, it is impossible to obtain the method of claims 5 or 6 of this invention by combining Obata with Bryan, i.e., by incorporating the protease treatment of Obata to the isoflavone separation process of Bryan that collects the insoluble matter but not the soluble matter.

For at least the above reasons and the same reasons provided above for claim 1, Applicants respectfully submit that claims 5-6 dependent from claim 1 also patently define over the prior art.

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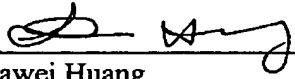
CONCLUSION

For at least the foregoing reasons, it is believed that all pending claims 1-6 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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